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TO: Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450ATTENTION: ~~Examiner~~ LIU

FAX NO.: 703-308-4556

PAGES: 8 (including cover page)

DATE: October 15, 2003

Applicant Docket No.: 329.1001-U

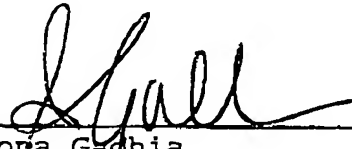
We are transmitting herewith papers for filing in:

RE: U.S. Patent Application of:	Gilbert, et al.
U.S. Patent Application No.:	10/066,323
Filed:	01/31/2002

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329.1001-U

UNITED STATES PATENT & TRADEMARK OFFICE

Examiner: LIU, Hong Art Unit: 1624
Re: Application of: Carl W. Gilbert, et al.
Serial No.: 10/066,323
Filed: January 31, 2002
For: **BIFUNCTIONAL ENERGY-
REVERSIBLE ACYL-COMPOSITIONS**

RESPONSE**VIA FACSIMILE 703-308-4556**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

October 15, 2003

Sir,

Responsive to the Office Action dated August 15, 2003, the following remarks are made:

In response to the restriction requirement, Applicants elect to further prosecute in this patent application Group I, claims 1-12, 14, 16, 22, 24, 25 and 31 drawn to the compounds of formula I wherein D is not a heterocycle, Z is not a piperazine and all other variables do not contain a heterocyclic ring.

This response is made with traverse and it is urged that the claims contained in Groups II-V be examined together with the claims designated as Group I by the Examiner. Reconsideration is respectfully requested.

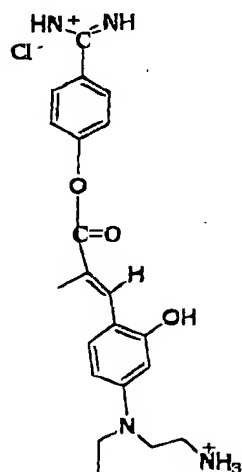
First, it is urged that the most compelling case for examining additional groups of claims in this application is found by considering the claims of Groups I and IV. The compounds of formula I in Group I are directed to cinnamate or related structural cores corresponding to a subformula: Z-CINN-X_i-A

the compounds of Group IV are conjugates linked to the compositions of formula I which are found in Group I. It is therefore urged that the compounds of Groups I and IV are intimately tied together and that a search of the art related to the compounds of Group I will substantially overlap with the search directed to the compounds of Group IV by virtue of the fact that any such conjugates of Group IV will include the starting material of Group I. Consequently, Applicants urge that there is no difference in the core portion of the formula and that they are all part of the same recognized class of cinnamate compounds in the art. Therefore, it would not be an undue burden upon the Examiner to search and consider the compositions of Groups I and IV at the same time.

Similarly, Applicants urge that the compounds of Groups II, III, and V be included with those of Group I. Specifically with regard to Group II, the fact that D and Z are different from the moieties identified by the Examiner in Group I is of secondary concern for search purposes since the overall composition to be searched is still the cinnamate core. This same rationale applies for the compounds identified as Group III in the restriction requirement.

Finally, with respect to the method of treatment claims identified as Group V, the method specifically requires that the mammal be treated with an effective amount of a composition of claim 1 which is found in Group I. Thus, there is a complete overlap of the search which is to be conducted with Group I and it would therefore not be an undue burden for the Examiner to search and consider all of the compounds identified in Groups I through V at this time.

In response to the requirement of election of species, Applicants elect to further prosecute in this case the species corresponding to



in the event that no generic claim is finally held allowable. See Example 2, page 24 of the specification in which the above-mentioned compound is identified as compound number 16. See also figure 2. This compound corresponds to formula I in claim 1 as follows:

R_1 is CH_3 ;

R_2 is H;

J is O;

R_3 is H;

R_4 is H;

R_5 is H;

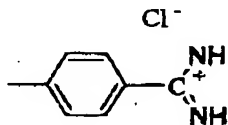
R_6 is H;

Z is NR_7R_8 where R_7 is CH_2-CH_2 ;

R_8 is $CH_2-CH_2-NH_3^+$;

X_1 is O; and

A is



The elected compound is shown as the salt. In the unprotonated form, R_8 is $CH_2-CH_2-NH_2$;

It is believed that claims 1-4, 11-14, 16, 20 and 25 currently read on the elected species.

This response to the requirement of the election of species is made with traverse. Reconsideration is therefore respectfully requested. It is believed that the claims specifically directed to all of the compounds of formula I in its entirety should be examined together and that the differences of species is not such as to require separate examinations. No separate search would be required in addition to that which should be performed for the compound identified above as the elected species. Each composition corresponding to formula I includes the same element, i.e. the cinnamate core, as the basis for the claimed composition as set forth in the generic claim (claim 1) and formula I. The differences in the values for each of the variables required by formula I are not such as to require separate examinations.

The Examiner has the discretion to prosecute all of the pending claims in a single patent application. In fact, "[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis added; Manual of Patent Examining Procedure, § 803, second paragraph).

Therefore, it is respectfully urged that a search of the art that is directed to the invention of elected Group I will also very likely overlap a search strategy directed to the subject matter of the invention of the non-elected groups. Thus, for reasons of efficiency in prosecution and searching, the Examiner is respectfully requested to reconsider and withdraw or modify the present Restriction Requirement.

FEES

This response is being filed with a petition for a one-month extension of time and proper fee. No further fees are believed to be required. If, on the other hand, it is determined that further fees are necessary or any overpayment has been made, the Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275.

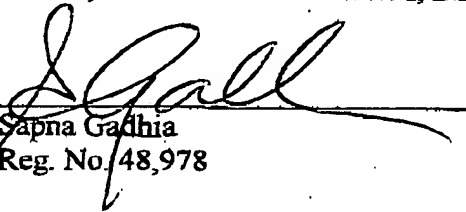
Pursuant to 37 CFR 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to the above-mentioned deposit account.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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By:


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October 15, 2003

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